

IN THE CLAIMS:

Please cancel claims 24-29 without prejudice.

REMARKS

The proposed drawing corrections were disapproved for failing to properly highlight the changes. Additionally, the drawings were objected to for failing to show how track elements 36 travel along guide elements 38; how rails 26 collapse; and showing clear operation of the latching structure 54. The drawings were objected to for failing to include reference numbers 56, 58, and 60. The specification was objected to for introducing new matter as well as several listed informalities. Claims 24-34 were rejected under 35 USC 112, first paragraph, as failing to enable the claimed structure. Claims 24-34 were rejected under 35 USC 112, second paragraph as failing to distinctly pointing out the claimed subject matter due to the Examiner's assertion of the disclosure as "vague". Claims 24, 25, 27 and 28 were additionally rejected under 35 USC 102(e)(2) as being anticipated by Atfanas (US 6,338,427). Claims 26 and 29-34 were rejected under 35 USC 103 (a) as being unpatentable over Atfanas in view of Parkins.

Objections to the Drawings

The Applicant respectfully submits amended drawings 1 through 4. The Applicant has highlighted the changes as required under MPEP 608.02(v). The track 36 and guide 38 drawings were objected to for failing to provide workable structure. The guide and track 38, 36 as originally illustrated was connected at the edge and therefore the contact was difficult for the Examiner to visualize. These guides have been moved to the center of the guide/track arrangement such that they are easier to conceptualize. The Applicant has added NO NEW MATTER by this amendment as the guide elements were described with more than sufficient detail for one skilled in the art to replicate without undue experimentation. The Applicant in making this statement is not attempting to convince the Examiner that the original written specification was more detailed than believed. Instead, the Applicant asserts that any engineer, even one with only the most passing familiarity with car racks, would

immediately upon hearing "a guide/track arrangement" have at his disposal and within his knowledge numerous non-experimental embodiments.

The Examiner similarly objects to the collapsible rails 26 as being ill-defined. The Applicant respectfully traverses this objection. The side rails are clearly illustrated in both an upright and a folded position as originally filed. Figure 3 was amended simply to conform to the description within the originally filed specification and not as an addition of new matter. The Applicant believes, however, that the Examiner may be having problems more with the folding mechanisms of the front and rear rail rather than the obvious rotating workings of the side rails. In order to eliminate this confusion of operation as to the front and rear rails, the Applicant has amended the drawings to only refer to the side rails as collapsible rails 26. The side rails are clearly illustrated rotating about a single bar and therefore would require absolutely no undue experimentation to replicate or design.

The latching structure 54 was similarly objected to for failing to adequately describe the required structure. The Applicant notes that due to the present amendments cancellation of claims 24-29, the locking mechanism is no longer an element of the claimed invention and therefore the adequacy of the claimed structure is mute.

The drawings as originally filed were objected to as failing to contain the reference number 56,58 and 60. The amended drawings contain such reference number and are highlighted as required by MPEP 608.02(v).

Objections to the Specification

The amendments to the specification were objected to as introducing new matter to the disclosure. The Examiner asserts that the addition of text to paragraph 14 added new matter pertaining to the movement of the storage surface. The Applicant respectfully traverses this objection but acknowledges that the issue is moot due to the present included amendment to claim 14. The Applicant respectfully traverses the Examiner's objection to the amendments made to

paragraph 18. The first two amendments in paragraph 18 simply add a descriptor term and reference number to structure already described as originally filed and are therefore not new matter. The amendments at the end of paragraph describing the pivot of the rails 42,44 was simply adding a description of what was clearly illustrated in the drawings as initially filed and therefore was not new matter. A simple mechanical rail system illustrated in a first position, then in a second position pivoted about a single point as compared to the first position, would provide more than adequate manufacturing information for anyone familiar with mechanics to form such a mechanism without requiring undue experimentation. Thus the addition of terms describing precisely what was illustrated in the drawings does not constitute the addition of new matter. Similarly, the Examiner objected to the addition of "flush position 60" to paragraph 19. The Applicant respectfully traverses the Examiner's objection. The Applicant notes that the specification as originally filed contained "a pivoting lock that can remain flush"... and therefore the addition of a descriptor and reference number does not amount to the addition of new matter.

The specification was further objected to for informalities listed in paragraph 6 of the final office action. The Applicant respectfully traverses these objections. It was asserts that it is unclear how rails 26 are collapsible. Although the Applicant understands how the Examiner may have found the mechanisms of the front and rear rail illusive, the mechanisms of the side rails clearly are illustrated pivoting about their connection with the track 36 and therefore are more than adequately disclosed. The drawings have been amended such that the confusion regarding the front and rear rails has been removed. Figure 2 was objected to for failing to illustrate a guide within track element 36. Although the Applicant asserts the track/guide description alone provides adequate disclosure, Figure 2 has been amended to help clarify such a relationship by moving the guide from the edges towards the center of the track element 36. The addition is not, therefore, new matter especially in light of the track/guide concept originally disclosed. Similarly, this clarifying amendment has been added to guide 38 in response to the Examiner's identical objection. Paragraph 19 has been amended to remove the reference to

reflect the correct number of mounting elements illustrated in the drawings. The Applicant respectfully traverses the Examiner's objections as to the operation of latch 54, how it remains flush, and how it cooperates with the rack. The latch is clearly illustrated flush in figures 1 and 4 and engaging the rack in Figure 2. Again, however, the Applicant notes that the claims have been amended such that the locking mechanism is not a claimed element and therefore objections to its description are moot.

Claims 30-34

Claims 30-34 were rejected under 35 USC 112 first and second paragraph as being non-enabling and indefinite respectively. The Applicant respectfully requests reconsideration of the patentability of the new claims 30-34. The Applicant notes that the basis for the Examiner's objection lie primarily with the folding mechanisms of the locking mechanism 54, the guide/track arrangement of the storage surface 32, and the folding mechanism of the collapsible rails 26. The Applicant respectfully notes that the locking mechanism is no longer a claimed element. The Applicant further notes that the guide/track arrangement has been modified without the addition of new matter to clarify the guide/track interaction. Finally the Applicant notes that the pivot nature of the collapsible rails 26 is more than adequately described and illustrated. Any confusion involving the mechanisms involved in the front and rear rails have been removed via amendments. The rotational connection illustrated in the side rails as originally filed is fully enabling and would require no experimentation, not to mention undue, to be produced by one skilled in the art. Therefore, the Applicant respectfully requests these objections be removed.

Claims 24, 25, 27 and 28

Claims 25, 25, 27 and 28 were rejected under 35 USC 102(e)(2) as being anticipated by Aftanas et al. Although the Applicant disagrees with the Examiner, the Applicant respectfully notes that the above rejection is moot in light of the amendments canceling claims 24-29.

Claims 26 and 29-34

Claims 26 and 29-34 were rejected under 35 USC 103(a) as being unpatentable over Aftanas et al. in view of Parkins. The Examiner asserts that Aftanas does not disclose a rotatable end rail yet Parkins does. The Examiner asserts it would have been obvious to combine Aftanas et al. with Parkins to arrive at the present invention. The Applicant respectfully traverses the Examiner's rejections. The Examiner has not presented any support in either prior art reference, or outside source to support the combination of these references. The folding rails of the Parkins patent are not even attached to the overall rack assembly as claimed and taught by the present invention and necessary to be incorporated into Aftanas. Furthermore, the Federal Circuit has stated that:

"rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." In re Rouffet, 149 F.3d at 1357, 47 USPQ2d at 1456; see also In re Werner Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)

And:

Because the Board did not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of Rouffet's invention to make the combination, this court infers that the examiner selected these references with the assistance of hindsight. This court forbids the use of hindsight in the selection of references that comprise the case of obviousness. See In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

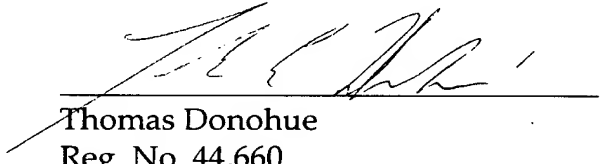
The Applicant therefore submits that the concerns of the Examiner towards claims 30-34 as disclosed in the present office action have been adequately addressed and should be reconsidered. The Applicant therefore kindly requests the Examiner to review new claims 30-34 in light of these changes and the aforementioned remarks.

CONCLUSION

The Applicant would like to thank the Examiner for his assistance. In light of the above amendments and remarks, Applicant submits that all objections and rejections are now overcome. Applicant has added no new material to the application by these amendments. The application is now in condition for allowance and expeditious notice thereof is earnestly solicited.

Should the Examiner have any questions or comments that would place the application in better condition for allowance, the Examiner is respectfully requested to call the undersigned attorney.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE DRAWINGS:

Please replace Figures 2, 3 & 4 with the attached amended drawings.

IN THE SPECIFICATION:

Kindly replace paragraph 14, page 3 with the following:

[0014] The roof rack system 10 includes at least one storage surface 20. The use of a storage surface 20 for mounting objects for transport is well known in the prior art. The at least one storage surface 20 is movable between a first position 22, where the at least one storage surface 20 is generally coincident to the roof portion 14 of the automobile 12, and a second position 24 (see Figure 2), where the at least one storage surface 20 is generally parallel to the side portion 16 of the automobile 12. The capability of moving the at least one storage surface 20 from the first position 22 to the second position 24 provides a variety of benefits. [A wide variety of known methods and configurations are known in the prior art that allow the at least one storage surface 20 to move between the first position 22 and the second position 24. These methods include track/guide arrangements, roller arrangements, ball bearing arrangements, and a variety of other known methods.]

Kindly replace paragraph 19, page 5 with the following:

[0019] The roof rack system 10 may further include a plurality of mounting elements 50. Although a variety of configurations are contemplated, in one embodiment the use of [three] two mounting elements 50 is contemplated. It is

contemplated that the mounting elements 50 may include latching areas 52. The latching areas 52 may be utilized as a convenient location to attach bungee cords or other securing straps commonly utilized to hold objects on the roof rack system 10. The present invention may further include a locking mechanism 54 for securing the storage surface 20 in the second position 24. Although a variety of locking elements 54 are contemplated by the present invention, in one embodiment the locking element 54 is a pivoting lock that can remain flush (flush position 60) with the side portion 16 of the vehicle 12 while the storage position 20 is in the first position 22 (see Figure 1) and may be swung out to lock the storage surface 20 in the second position 24 (see Figure 2).

IN THE CLAIMS:

Please cancel original claims 24-29 without prejudice.